

12



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,843	08/02/2001	Yoshihiko Obata	1506-1010	5667
21171	7590	10/28/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,843

Applicant(s)

OBATA, YOSHIHIKO

Examiner

John Van Bramer

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A program, in and of itself, is considered functional descriptive material and therefore is not patentable (See MPEP 2106(IV)(B)(1)(9)).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Garg et al. (U.S. Patent Number: 6,571,216). ”.

5. Claim 1: Garg et al. discloses a customer-based product design module which incorporates a profit sharing method executed by a server computer, comprising:

a. a step of obtaining pieces of answer information each specifying an option selected by a participant from options corresponding to an element which characterizes a commercial article (user chooses numbers for a lottery) (Col. 9, lines 11-19).

b. a step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step (the resultant winning lottery ticket numbers) (Col 8, lines 65-67 and Col 9, lines 1-3).

c. a step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (The set of possible winning number combinations) (Col. 9, lines 2-3)

d. a step of determining an individual return value which should be given to the participant in accordance with the points assigned to the participant (a payout schedule based upon the number of correctly chosen numbers) (Col 9, lines 14--17).

6. Claims 1, 3, and 5 through 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar (U.S. Patent Number: 6,694,355). "

7. Claim 1: Bahar discloses a customer-based product design module which incorporates a profit sharing method executed by a server computer, comprising:

a. a step of obtaining pieces of answer information each specifying an option selected by a participant from options corresponding to an element which characterizes a commercial article (Col. 6, lines 29-32).

b. a step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step (Col 6, lines 29-32).

c. a step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35)

d. a step of determining an individual return value which should be given to the participant in accordance with the points assigned to the participant (the award incentive) (Col 6, lines 29--32).

8. Claim 3: Bahar discloses a method according to claim 1, wherein each piece of answer information specifies, as to a plurality of elements, options which characterize the commercial article, respectively (Col 9, lines 14--17).

9. Claim 5: Bahar discloses a method according to claim 1, further comprising a step of transmitting a piece of selection information indicating

the options corresponding to the element to a client computer of the participant that is connected to said server computer (Col 4 lines 21-24).

10. Claim 6: Bahar discloses a method according to claim 1, further comprising a step of creating image data of the article characterized by the adopted option (Col 6, lines 59-62).

11. Claim 7: Bahar discloses a profit sharing method executed by a client computer connectable to a server computer, comprising:

a. A step of obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to an element which characterizes a commercial article (Col. 6, lines 29-32).

b. A step of sending the answer information obtained in said obtaining step to the server computer for making said server computer execute (Col 6, lines 13-16).

c. A step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step (Col. 6, lines 29-32).

d. A step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (The measure

of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35)

e. A step of determining individual return values should be respectively given to participants in accordance with the point assigned to the participants. (Col 6, lines 29--32)

12. Claim 8: Bahar discloses a computer readable medium containing a profit sharing program comprising:

a. A module making a server computer execute a step of obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to an element which characterizes a commercial article. (Col 6, lines 29-32 and lines 13-16).

b. A module making the server computer execute a step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step. (Col 6, lines 29-36).

c. A module making the server computer execute a step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35)

d. A module making the server computer execute a step of determining individual return values should be respectively given to participants in accordance with the points assigned to the participants.
(Col 6, 29-33)

13. Claim 9. Bahar discloses a program product comprising:

a. A module making a server computer execute a step of obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to an element which characterizes a commercial article. (Col 6, lines 29-32 and lines 13-16).

b. A module making the server computer execute a step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step.
(Col 6, lines 29-36).

c. A module making the server computer execute a step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (Col 6, 33-36)

d. A module making the server computer execute a step of determining individual return values should be respectively given to

participants in accordance with the points assigned to the participants.

(Col 6, 29-33)

14. Claim 10: Bahar discloses a profit sharing system comprising:
- a. A server computer connectable to a client computer. (Col 4, lines 55-58)
 - b. A storing device containing a profit sharing program comprising. (Col 4, lines 7-9)
 - c. A module making the server computer execute a step of obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to an element which characterizes a commercial article. (Col 6, lines 29-32 and lines 13-16).
 - d. A module making the server computer execute a step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step. (Col 6, lines 29-36).
 - e. A module making the server computer execute a step of assigning predetermined points to a participant who selected the option equivalent to said adopted option. (The measure of each degree of

variance between the final design and the pre-determined design scheme)

(Col. 6, lines 32-35)

f. A module making the server computer execute a step of determining individual return values should be respectively given to participants in accordance with the points assigned to the participants.

(Col 6, 29-33)

15. Claim 11: Bahar discloses a commercial article developing method comprising:

a. A step of obtaining pieces of answer information each specifying at least an option selected by a participant from options corresponding to an element which characterizes a commercial article.

(Col 6, lines 29-32 and lines 13-16).

b. A step of specifying one option as an adopted option corresponding to the element, based on the pieces of answer information obtained in said obtaining step. (Col 6, lines 29-36).

c. A step of developing a commercial article on the basis of the adopted option specified in said specifying step. (Col 6. lines 37-39)

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 2: is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar in view of Murphy (MM, MM ... BLUE! PUBLIC OBVIOUSLY WAS READY FOR A CHANGE IN M&M COLORS: [CITY Edition] Marli Murphy KANSAS CITY STAR. Dayton Daily News. Dayton Ohio: Aut 19, 1995. pg. 3.C) which disclose a manufactured commercial article in which participants determined the design of a product enhancement. Specifying such a technique in Bahar would have been obvious to one of ordinary skill in the art at the time of the application in view of Murphy so as to allow the manufacture to identify current trends and maximize potential sales. In fact, Bahar mentions (Col 6, lines59-63) that such identification would benefit the manufacturer.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar in view of Crane (Burton Crane "The Sophisticated Investor", 1964. Crane (page 230, lines 3-14) which discloses a method for sharing

corporate profit by means of a dividend. This method includes determining "a unit return value" by dividing corporate profits by the number of shares outstanding. The "individual return value" is then calculated by multiplying the unit return value by the participation points (or shares). Modifying or including such a step in the teachings of Bahar would have been obvious to one of ordinary skill in the art at the time of the application in view of Crane in order to provide proportional disbursement to participants as a reward.


Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eggleton et al. (U.S. Patent Number 6,061,660) is cited for showing a similar profit sharing or incentive program in which users participate. Abelow (U.S. Patent Number 5,999,908) for showing a consumer driven product design methodology.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600